

REMARKS

The Invention

In general, the present application relates to a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (e.g., a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). This is advantageous because not all 3G networks are capable of supporting data services and by including information regarding the 3G data capabilities of the network in the preferred roaming list the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed.

Status of the Claims

Claims 29-33, 35-41, 43 and 44 are pending in the application.

Claims 1-28, 34 and 42 are withdrawn from consideration.

Claims 29-33, 35-36, 37-41, and 43-44 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 29-33, 35, 37-41, and 43-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Islam et al.*, U.S. Patent Publication No. US2005/0090277A1 in view of *Almgren* (WO 2004/0066663A1).

Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Islam* (US2005/0090277A1) in view of *Almgren* (WO 2004/0066663A1) and further in view of *Russell*, U.S. Patent Publication No. US2004/0249915.

Claims 29-33, 35-36, 37-41, and 43-44; Rejected under 35 U.S.C. § 112, first paragraph

Claims 29-33, 35-36, 37-41, and 43-44 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Examiner contends that the specification does not disclose a mobile data device creating a ranking of available networks. Applicants disagree.

Applicants believe that the specification is sufficiently descriptive, to one skilled in the art, to support Claims 29-33, 35-36, 37-41, and 43-44. Initially, it is noted that the specification recites the following:

a method of providing a mobile data device in a wireless system with information about preferred networks to connect to, said mobile data device having a preferred roaming list with a list of networks, the method comprising the steps of: adding to the preferred roaming list information about whether each said network in said list of networks supports third generation data capabilities; adding to the preferred roaming list information about whether each said network in said list of networks supports data roaming; adding to the preferred roaming list information about whether each said network in said list of networks supports Mobile IP service; adding to the preferred roaming list information about whether each said network in said list of networks supports an always-on feature; and **determining preferred networks based on information within said preferred roaming list** including a geographic area and whether said network supports third generation data capabilities, data roaming, Mobile IP service and always-on feature; whereby, within said geographic area, said mobile data device firstly prefers those of said networks which support said third generation data capabilities over networks which do not support said third generation data capabilities, secondly prefers those of said networks which support said data roaming over networks which do not support said data roaming, thirdly prefers those of said networks which support said Mobile IP service over networks which do not support said Mobile IP service, and fourthly prefers those of said networks which support said always-on feature over networks which do not support said always-on feature

Page 3, line 27- Page 4, line 17 (emphasis added).

The PRL table can be modified and loaded onto the mobile device through known methods within the art. Further, **the mobile device can be programmed to select preferred networks based on the modified PRL table.**

Page 10, lines 19-22 (emphasis added).

In a preferred embodiment, the carrier could update the device by downloading a new PRL when the user changes their service plan.

Page 11, lines 27-28.

Applicants believe that a person of ordinary skill in the art, to which the application is directed, reading the above paragraphs in the context of the application would understand that the mobile device first tries to acquire the network it just lost (see page 6) and, failing that, "The PRL then ranks the priority of each [available] system." A person of ordinary skill in the art would understand in lingo of the art that the "PRL" recitation encompasses the PRL list itself and related functionality including functionality of manipulating the list such as, for example, ranking available networks.

Accordingly, one skilled in the art would be enabled to perform the method as recited in Claims 29-33, 35-36, 37-41, and 43-44 and the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

Claims 29-33, 35, 37-41, and 43-44; Rejected under 35 U.S.C. § 103(a)

Claims 29-33, 35, 37-41, and 43-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Islam et al.*, U.S. Patent Publication No. US2005/0090277A1 in view of *Almgren* (WO 2004/0066663A1). Initially it is noted that, and as shown in the assignment attached as Exhibit 1, *Islam* is a co-pending application assigned to the assignee of the present application. Further it is noted that:

The present Application, U.S. Patent Application Serial No. 10/755,812 and *Islam*, U.S. Patent Application Serial No. 10/693346, were, at the time the invention of U.S. Patent Application Serial No. 10/755,812 was made, owned by, or subject to an obligation of assignment to, the same company.

Accordingly, under 35 U.S.C. § 103 (c) and MPEP § 706.02(I)(1), Applicants assert that *Islam et al.*, U.S. Patent Publication No. US2005/0090277A1 is excluded as prior art to the present application.

If the Examiner chooses not to exclude *Islam*, Applicants further note that the Examiner has not properly supported the rejection under 35 U.S.C. § 103(a). That is, *Islam* discloses a method and apparatus for selecting a base station transceiver system based on service communication type. In one illustrative example, one or more base station transceiver systems are identified for communication with the mobile station

through a scanning process. A first base station transceiver system is identified as providing a Third Generation (3G) communication service or better, whereas a second base station transceiver system is identified as failing to provide the 3G or better communication service (e.g., it may provide a Second Generation (2G) communication service). The first system is selected for communication over the second system based at least in part on identifying that the second system fails to provide the 3G or better communication service. For example, the first system may be chosen over the second system if the first system has a signal quality that is better than a minimum threshold, even if its signal quality is worse than that of the second system.

Almgren, on the other hand, discloses a system wherein a preferred list of networks exists within the mobile device which is ranked and stored. The method of *Almgren* is designed to move the mobile device into a more preferred network according to that ranking by changing an "elementary file" stored on the mobile device. That is, *Almgren* describes a mobile device trying in reverse priority order to register to a network in a list of prioritized networks. There is no teaching in *Almgren* of how the list of networks is prioritized. Nor is there a teaching in *Almgren* of how available networks which are not on the list are considered. Applicants respectfully submit that page 14 lines, 11 to 24 of *Almgren* only describes, as specifically stated at lines 15 to 16, "A first file contain[ing] a list of networks to be used in a priority order in a roaming situation." *Almgren* goes on to specify the scope of the "use" on the same page 14 at lines 21 to 26: "When the subscriber roams from one network to another he is connected to a network with the highest possible preference in said list. This means that the network with the highest priority is tried first and if that network is not available, the next network in the list is tried and so on until a connection is achieved. Thus, the selected network is in practice not always the highest priority network according to the list." It would be very clear to a person of ordinary skill in the art that *Almgren* teaches compliance with the network list and not the modification of such a list. There is no teaching on page 14 lines, 11 to 24 of *Almgren* how available networks which are not on the list are considered.

Applicants respectfully submit that the list of preferred networks taught by *Almgren* is stored in file EF PLMN and Fig. 2 only teaches amending file EF LOCI

which does not store any list of networks. There is no guarantee of an overlap between the networks in the list and the available networks.

Nowhere in either cited reference is there a teaching, suggestion, or incentive to combine these very different references.

In *KSR International Co. v. Teleflex Inc.*, ___ U.S. ___, ___, 2007 WL 1237837 (2007), the Supreme Court stated the following with respect to the determination of obviousness under 35 U.S.C. § 103:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.* This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Id., at 14 (emphasis added).

In addition, the Supreme Court further noted that:

Often, *it will be necessary* for a court to *look to* interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and *the background knowledge possessed by a person having ordinary skill in the art*, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness”).

Id., at ___ (emphasis added).

It is further noted that, *In re Fine*, 837 F.2d 1071 held that, although some of the cited references, individually, may have some of the claimed inventions' features, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." *Id.* at 1075. Instead, to reach the proper conclusion under §103:

the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that* time to *that* person.

Id. at 1073-74.

It is noted that *Islam* was published Apr. 28, 2005 and *Almgren* was published Aug. 5, 2005. Both of these applications were published after the filing date of the present application. As noted by the Court in *KSR*, the Examiner must present evidence that the cited art was in *the background knowledge possessed by a person having ordinary skill in the art*. However, with regard to this rejection, it is evident that the technology disclosed in *Islam* and *Almgren* was not possessed by a person having ordinary skill in the art. As such, the Examiner has failed to present a *prima facie* case of obviousness.

Further, the motivation to combine provided by the Examiner is "*Islam* differs from claims 29 and 37 in that he does not specifically teach: mobile data device gives preference to various one of the plurality of criteria to create ranking of available networks. However, *Almgren* discloses a roaming method which teaches ... [a] mobile device giv[ing] preference to various ones of the pluralities of system preferences criteria to create a ranking of available networks." The Examiner then proceeds to state that these elements could be combined to create a mobile device incorporating all of these features. Applicants respectfully submit that a statement as how the present application differs from a specific prior art reference, while another reference discloses the lacking elements is immaterial to an assertion of a motivation to combine. That is, the Examiner is simply identifying references that, individually, may have some of the claimed inventions' features. However, as noted in *Fine*, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." Moreover, this simple recitation of what elements are shown in the different references followed by an assertion that the elements could be combined in a single invention does not amount to an "articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness" as required by *KSR*.

That is, the Examiner did not provide the necessary objective evidence of any teaching, motivation or suggestion for combining the references to enable an application of Section 103(a), as cited. In asserting U.S.C. 103(a), Applicants submit that the Examiner is required to provide such evidence. *In re Lee*, 61 USPQ 2d 1430 (CAFC 2002) states that "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness"; *In re Lee*, *supra*, also states that the rationale for combining references "must be based on objective evidence of record" and cannot be "resolved on subjective belief and unknown authority". See *Id.* at 1433 and 1434.

Further, Applicants note that *Almgren* teaches away from the invention of the present application. That is, *Almgren* at page 5, lines 4 to 7 states, "The most basic form of Roaming Management is to define the contents of the roaming control files, i.e. the PLMN list ..., on the SIM cards at the time of issuance. This becomes a static definition of preferred roaming networks." A person of ordinary skill in the art reading *Almgren* would therefore understand that the PLMN list taught by *Almgren* addresses minimization of cost overheads for carriers at the expense of service and service quality delivered to the subscriber. Therefore, *Almgren* teaches away from the claimed invention which is directed at acquiring the best available network from the service prospective at the expense of service quality irrespective cost considerations.

Accordingly, the rejection of Claims 29-33, 35, 37-41, and 43-44 under 35 U.S.C. § 103(a) as being unpatentable over *Islam et al.*, U.S. Patent Publication No. US2005/0090277A1 in view of *Almgren* (WO 2004/0066663A1) is improper and should be withdrawn.

Claim 36: Rejected under 35 U.S.C. § 103(a)

Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Islam* (US2005/0090277A1) in view of *Almgren* (WO 2004/0066663A1) and further in view of *Russell*, U.S. Patent Publication No. US2004/0249915. It is noted that *Russell* was published Dec. 9, 2004. Thus, as set forth above, this reference was not in the background knowledge possessed by a person having ordinary skill in the art as required

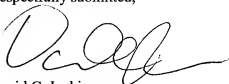
by the Court in *KSR*. Further, the Examiner has merely identified a single element from *Russell* and stated that it could be combined with the inventions of *Islam* and *Almgren*. Thus, the Examiner is again identifying references that individually have some of the claimed inventions' features and using hindsight reconstruction to assemble the invention claimed in the present application. Such a method of making a determination of obviousness violates *Fine*. Further, after identifying the single element in *Russell*, the Examiner merely states that the element could be combined with the other cited art. This is not an "articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness" as required by *KSR*.

Accordingly, the rejection of Claim 36 under 35 U.S.C. § 103(a) as being unpatentable over *Islam* (US2005/0090277A1) in view of *Almgren* (WO 2004/0066663A1) and further in view of *Russell*, U.S. Patent Publication No. US2004/0249915 is in error and should be withdrawn.

CONCLUSION

In view of the remarks above, Applicants respectfully submit that the application is in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. C. Jenkins', with a long horizontal flourish extending to the right.

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EXHIBIT A

ASSIGNMENT

WHEREAS, new and useful improvements have been made by the undersigned in

METHOD AND APPARATUS FOR SELECTION A BASE STATION TRANSCEIVER SYSTEM BASED ON SERVICE COMMUNICATION TYPE

and are the subject of a patent application prepared for filing with the United States Patent and Trademark Office attached hereto, and executed by the undersigned on the dates indicated below in the appropriate spaces to the left of the signatures of the undersigned, which application is further identified as Jones Day Docket No. 555255012610.

WHEREAS, RESEARCH IN MOTION LIMITED, a corporation organized under the laws of the Province of Ontario, CANADA, having a place of business at 295 Phillip Street, Waterloo, Ontario, CANADA, N2L 3W8, hereinafter referred to as "assignee", is desirous of acquiring all right, title, and interest throughout the world in, to, and under said improvements and inventions and patent rights therefor.

NOW, THEREFORE, be it known that, for valuable consideration, the receipt and sufficiency of which are hereby acknowledged, all right, title, and interest, in the United States and throughout the world, in, to and under said improvements and inventions and all patents, patent applications, patent rights, and inventor's certificates thereof, therefor, and therein, including without limitation said application for patent in the United States, all divisions and continuations thereof, all patents which may be granted thereon, all reissues and extensions thereof, all right to sue for past infringement thereunder, all patents which may be granted for said improvements and inventions by states or nations other than the United States, or by other authority, entity, or organization, and all applications therefor, have been and are hereby sold, assigned, transferred, and delivered unto assignee, its successors and assigns; and it is covenanted and agreed by the undersigned, and for executors, administrators, and legal representatives of the undersigned, that at assignee's request any and all applications, affidavits, assignments, and other instruments will be made, executed, and delivered as may be necessary, or desirable to secure for or vest in assignee, its successors or assigns, any improvement, inventions, right, title, interest, application, patent, patent right or other right or property covered by this assignment, and the United States Commissioner of Patents and Trademarks is hereby requested and authorized to issue any and all United States patents granted on any of said applications to assignee as owner of the entire right, title, and interest in, to, and under the same, and appropriately empowered officials of foreign countries are hereby authorized to issue any letters patent granted on any of said applications to assignee as owner of the entire right, title and interest in, to, and under the same.

The undersigned hereby grants the firm of JONES DAY the power to insert on this assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document.

IN WITNESS WHEREOF, this assignment has been executed below by the undersigned:

Date: Nov 3, 2003

Kalam
M. Khaledul Islam
88 Broughton Street
Kanata, Ontario K2K 3N4
CANADA

STATEMENT BY WITNESS

I, LUIS PABLO ESTABE, whose full Post Office address is

51 RUE DE L'ÉTOILE, GATINEAU, QC, J0A 3J3
(Address of Witness) CANADA

hereby declare that I was personally present and did see the above named person, personally known to me to be the person named in the assignment, duly sign and execute the same.

Date: Nov 3, 2003

LPE
(Signature of Witness)

IN WITNESS WHEREOF, this assignment has been executed below by the undersigned:

Date: 3rd Nov. 2003

Asif Hossain
Asif Hossain
163 Flamborough Way
Kanata, Ontario K2K 3H9
CANADA

STATEMENT BY WITNESS

I, LUIS PABLO ESTAYE, whose full Post Office address is

51 RUE DE L'ALOUETTE GATINEAU, QC, J8A 3J3
(Address of Witness) CANADA

hereby declare that I was personally present and did see the above named person, personally known to me to be the person named in the assignment, duly sign and execute the same.

Date: NOV 3, 2003

LPE
(Signature of Witness)